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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/030,727	05/13/2002	Adam Joshua Wynne	2277.1005000	8257
21005 7590 07/11/2008 HAMILTON, BROOK, SMITH & REYNOLDS, P.C. 530 VIRGINIA ROAD P.O. BOX 9133 CONCORD, MA 01742-9133				
EXAMINER				
LE, KHANH H				
ART UNIT		PAPER NUMBER		
3688				
MAIL DATE		DELIVERY MODE		
07/11/2008		PAPER		

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/030,727

Applicant(s)

WYNNE, ADAM JOSHUA

Examiner

KHANH H. LE

Art Unit

3688

Period for Reply -- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 21 February 2008.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-16 and 19-22 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-16 and 19-22 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 21 February 2008 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☒ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB/808)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

DETAILED ACTION

1. This Office Action is responsive to the response on 02/21/08. Claims 1-16, 19-22 were and are still pending. No amendment was made to the claims. Claims 1 and 11 are independent.

Oath/Declaration

2. Applicant's Attorney acknowledged that the claims have been twice amended by entry of the Article 34 Amendment and by entry of a preliminary amendment filed on January 11, 2002 and requested deferral of the request for a Supplemental Declaration until a Notice of Allowance is issued. This is acceptable however the objection is maintained.

Drawings

3. Previous objections to the drawings are withdrawn following amendment thereof.

Claim Rejections - 35 USC § 112

4. Previous rejection of claim 10 under this section is withdrawn, following correction thereof.

Claim Rejections - 35 USC § 102

5. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

6. Claims 1-9, 11-16, 19-22 are rejected under 35 U.S.C. 102(b) as being anticipated by Penkava et al, WO 95 35533 A.

Independent claims 1 and 11:

PENKAVA discloses a database with information relating to identified computers (page 32 lines 13-17) whereby the information is linked to these computers by their respective unique identifiers (page 16 lines 3-22).

Thus PENKAVA discloses:

A method and system for identifying a computer connected on-line to a remotely located site (e.g. Figures 3-4 item 60 and associated text; page 12 lines 2-4; page 32 lines 13-17) comprising the steps of:

searching a hard disk associated with the computer for an identifying element inherent to the computer (page 14, lines 4-6; e.g. a serial number: page 16 lines 3-22);

combining such an identifying element, when found, together with other identifying information associated with the hardware of the computer, to form a unique identifier for that computer (page 16 lines 3-22: e.g. combining the computer serial number with other computer inherent characteristics);

comparing the unique identifier for the computer ("validation number", see e.g. (Figure 4 step 44, which includes the combination of computer inherent characteristics above, Figure 4 step 42) to a store (database: page 32 lines 13-17; see Fig. 6 and associated text) of such unique identifiers available to the remote site;

if the unique identifier is present in the store, accessing data which is available to the remote site and which is associated with that unique identifier (page 30 line 16 to page 32 lines 13-17: e.g. the accessed data is whether user has bought the software or tried it, etc.); and

if the unique identifier is not present in the store, then storing it in the store and recording against it data associated with that computer (these steps are interpreted as building a database of registered identifiable computers on the remote site: page 32 lines 13-17; implicit in PENKAVA).

As to “the data relating, at least partially, to a credit record of previous transactions effected from that computer”, PENKAVA does not specifically disclose such.

However such data is non-functional descriptive material because no steps are performed on the particular data.

The Examiner need not give patentable weight to descriptive material absent a new and unobvious functional relationship between the descriptive material and the substrate. See In re Lowry, 32 F.3d 1579, 1583-84, 32 USPQ2d 1031, 1035 (Fed. Cir. 1994); In re Ngai, 367 F.3d 1336, 1338, 70 USPQ2d 1862, 1863-64 (Fed. Cir. 2004). In re Gulack, 703 F.2d 138 1, 1385,217 USPQ 401,404 (Fed. Cir. 1983) (*when descriptive material is not functionally related to the substrate, the descriptive material will not distinguish the invention from the prior art in terms of patentability*).

When the prior art describes all the claimed structural and functional relationships between the descriptive material and the substrate, but the prior art describes a different descriptive material than the claim, then the descriptive material is non-functional and can not be given any patentable weight. Such a scenario presents no new and unobvious functional relationship between the descriptive material and the substrate.

In this instance, none of the structure or functionality found in the limitations of claim 1 is due to the information recited. That is the particular information neither enhances nor diminishes the structure and functionality of the underlying database. Here the “structure or functionality” refers to the recited database, computer and remote site and to the

storing and accessing of data steps. The pieces of information received into the database are only a compilation of data, that coincides with the definition of non-functional descriptive material in MPEP 2106.

See also the following USPTO Board of Appeals and Interferences Informative Decisions for similar analyses:

Ex parte James Prescott Curry,
<http://www.uspto.gov/web/offices/dcom/bpai/its/fd050509.pdf>

Ex Parte Herman Mathias,
<http://www.uspto.gov/web/offices/dcom/bpai/its/fd051851.pdf>, (affirming a 35 USC section 102 rejection) (also affirmed at the CAFC (August 17, 2006)).

Claims 2 and 12:

PENKAVA discloses a method or system as in claims 1 and 11 above but does not disclose the data associated to that computer, and against which the unique identifier is recorded, relates to further data associated with such previous transactions.

However, as indicated above, as to the independent claims, that data is **non-functional descriptive material**, and is not given patentable weight. In re Gulack, 703 F.2d 138 1, 1385,217 USPQ 401,404 (Fed. Cir. 1983) (*when descriptive material is not functionally related to the substrate, the descriptive material will not distinguish the invention from the prior art in terms of patentability*).

Claims 19 and 21:

Art Unit: 3688

PENKAVA discloses a method or system as in claims 2 and 12 above but does not disclose said further data comprises credit card details used during such previous transactions.

However, as already indicated above, that data is **non-functional descriptive material**, and is not given patentable weight. In re Gulack, 703 F.2d 138 1, 1385,217 USPQ 401,404 (Fed. Cir. 1983) (*when descriptive material is not functionally related to the substrate, the descriptive material will not distinguish the invention from the prior art in terms of patentability*).

Claims 3-4 and 20, 13-14 and 22:

PENKAVA discloses a method or system as in claims 1 or 2, 11 or 12 above and further discloses the identifying element that is searched for on the hard disk is a predetermined number or type of number , unique to the hardware of the computer, and is a serial number of the hard disk (page 16, lines 3 to 22).

Claim 8:

PENKAVA discloses a method or system as in claims 1 or 2 or 11 or 12 above and further discloses the unique identifier is sent to the remote site, from where it is compared to the store (e.g. Figure 4 item 60; page 12 lines 2-4; page 32 lines 13-17).

Claims 5-6 and 15-16:

PENKAVA discloses a method or system as in claims 1 or 2 or 11 or 12 above and further discloses the other identifying information is information that is associated with the geometry of the hard disk and includes the number of sectors, platters and cylinders in the disk. (page 16, lines 3 to 22).

Claims 7 and 9:

PENKAVA discloses a method as in claims 1 or 2 above and further discloses the combining function is performed on the computer (page 16, line 31 et seq.) and is an encryption process (Figure 2 item 42, page 11 lines 17-18) done to obtain the level of uniqueness or security desired (page 16, lines 15-17).

Claim Rejections - 35 USC § 103

7. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

8. **Claim 10 is rejected under 35 U.S.C. 103(a) as being unpatentable over PENKAVA as applied to claim 9 above, and further in view of Official Notice.**

Claim 10:

PENKAVA discloses a method as in claim 9 above and further discloses a checksum encryption and authentication process using the user unique hardware characteristics (page 16 line 31-page 19 line 23; Figures 6, 16) to ensure correct identification of the user computer (page 19 lines 10-23). However, PENKAVA does not specifically disclose a 'hash-type' encryption and authentication process.

However hash type encryption is a common encryption and authentication method and has been known to be a substitute for checksum encryption and authentication (see e.g. Elliott, US 6468160 B2, col. 33 lines 36-39). Thus, it would have been obvious to a Phosita to substitute such hash type method to PENKAVA's checksum as an alternate encryption encryption and authentication method, to achieve the desired and predictable result of properly securing data.

Response to Arguments

9. Applicant's arguments have been fully considered but they are not persuasive. **The following is an integral part of the grounds of rejection.**

Applicant argues:

In Penkava, the validation code, which is a unique identifier (or "fingerprint") of the target computer hardware (see Figure 6), is generated on the target computer. The validation code is transient and exists only during activation of the software (see page 30, lines 17-21) and therefore cannot be stored remotely for subsequent use. Therefore the validation code cannot be used as an index in the information database 63 on the remote activation computer 60 (see page 32, lines 13-17) as suggested by the Examiner.

However the validation code contains not only the customer ID, product Id, system characteristics (See Fig. 6) but also, in an embodiment, an indication of at least a "try and buy" option. i.e. indicating whether the software allows the user to try it before buying and whether the user has bought after a certain number or time limit of trial(s) (page 30 line 33 to page 32 line 12). The "try and buy" status is passed on between the user and the operator at the remote location page 31 lines 16-20). The operator at the remote location updates the remote database, associating the validation number with the "try and buy" status (page 32 lines 13-17).

This means that, contrary to argument, Penkava does teach storing unique identifiers in the store and recording against them data associated with the identified computers, in this case at least the status of trials or whether or not user has bought the software."

This also means that, contrary to argument, Penkava implicitly does teach "comparing the unique identifier... to a store of such unique identifiers available to the remote site" and "if the unique identifier is not present in the store, then storing it in the store and recording against it data associated with that computer." in order to register new computers and record their buy and try status.

Notwithstanding that Penkava teaches a thumbprint stored locally as argued, nothing in the claims prohibit a single bi-directional interaction (as Penkava is argued to do), or requires generation of a unique fingerprint of the target computer whenever the target computer logs on to the remote site (as the instant application is alleged to teach). Such arguments exceed the scope of the claims.

Conclusion

10. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Khanh H. Le whose telephone number is 571-272-6721. The Examiner works a part-time schedule and can normally be reached on Tuesday, Wednesday, and Friday 9:00-6:00.

If attempts to reach the Examiner by telephone are unsuccessful, the Examiner's supervisor, James W. Myhre can be reached on 571-272-6722. The fax phone numbers for the organization where this application or proceeding is assigned are **571-273-8300** for regular communications and for After Final communications. Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 571-272-3600. For patent related correspondence, hand carry deliveries must be made to the Customer Service Window (now located at the Randolph Building, 401 Dulany Street, Alexandria, VA 22314)..

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished

Art Unit: 3688

applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

July 5, 2008

/Khanh H. Le/

Examiner, Art Unit 3688

/James W Myhre/

Supervisory Patent Examiner, Art Unit 3688